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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,328	07/22/2004	Hansulrich Reisacher	255583USOPCT	9831
22850	7590	05/16/2006		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER HAILEY, PATRICIA L	
			ART UNIT	PAPER NUMBER

1755

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/501,328

Applicant(s)

REISACHER ET AL.

Examiner

Patricia L. Hailey

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08/08/05, 02/15/06.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Applicants' remarks and amendments, filed on February 15, 2006, have been carefully considered. Claim 2 has been canceled; no new claims have been added.

Claims 1 and 3-9 remain pending in this application.

*Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Applicants' Priority Document was filed on July 22, 2004.

*Withdrawn Rejections and Objections*

The objection to claims 1-9 stated in the previous Office Action has been withdrawn in view of the Examiner's reconsideration of the instant claims.

The 112(2) rejection of claim 8 stated in the previous Office Action has been withdrawn in view of Applicants' amendment thereto.

*New Objection*

The following New Objection is being made in view of Applicants' amendment to claim 1.

*Claim Objections*

2. *Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.*

The phrase "wherein said component (B) comprises alkylene oxide adducts with amines or alcohols" is now in both claims 1 and 3 (which depends from claim 1).

Additionally, Applicants' remarks entitled "SUPPORT FOR THE AMENDMENTS", include a statement that claim 3 has been canceled, and that the subject matter therein has been incorporated into claim 1. However, Applicants' remarks regarding the rejection of record state: "Claims 1 and 3-9 are pending." (emphasis added), and claim 3 appears in Applicants' list of pending claims. Clarification is respectfully requested.

*Maintained Rejection*

3. The following rejection of record is maintained; the text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

*Claim Rejections - 35 USC § 103*

4. *Claims 1 and 3-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nyssen (U. S. Patent No. 6,646,023).*

*With respect to claims 1, 3, 4, and 9:*

Nyssen teaches solid pigment preparations comprising at least one organic or inorganic pigment, and at least one compound selected from the group consisting of polyether polyols, reaction products of alkylene oxides with alkylatable compounds such as fatty alcohols, said preparations having a mean weight average particle size of 20 to 2000  $\mu\text{m}$ . The solid pigment preparations are preferably obtained in the form of readily flowable, low-dust granules by spray-drying methods. See col. 2, lines 41-62 of Nyssen, as well as col. 7, lines 31-43, where an exemplary preparation comprising 30-99%<sup>^</sup> by weight of the organic or inorganic pigment and 1 to 100% by weight, based on the amount of the organic or inorganic pigment, of the aforementioned at least one compound, is disclosed (considered to read upon the percentage ranges of claim 1).

This disclosure is considered to read upon the limitations "at least one pigment" and "at least one nonionic surface-active additive based on polyethers", i.e., Applicants' components (A) and (B) in the instant claims.

The organic or inorganic pigments are not subject to any limitation; exemplary pigments are disclosed by Nyssen at col. 2, lines 1-65.

Suitable compounds from the group of polyether polyols include block copolymers of ethylene oxide and/or propylene oxide (considered to read upon the limitation "alkylene oxide block copolymers" in claim 2), as well as block copolymers obtained by subjecting ethylene oxide and/or propylene oxide onto bifunctional

alcohols or amines (considered to read upon the limitations of claims 3 and 4). See col. 3, line 66 to col. 4, line 21.

*With respect to claims 5 and 6:*

Nyssen discloses that the solid pigment preparations can be prepared in such a manner that the inorganic or organic pigment component is subjected to wet comminution in aqueous or aqueous-organic medium together with at least some of the at least one compound, followed by subsequent drying. See col. 7, lines 44-52 of Nyssen (considered to read upon claim 5).

Suitable drying methods include single-material spray-drying using high-pressure nozzles or spiral chamber nozzles (considered to read upon the limitation "spray tower" in claim 6). See col. 7, line 62 to col. 8, line 35 of Nyssen.

*With respect to claims 7 and 8:*

The pigment preparations may be used as colorants for coloring seed and seed-dressing materials (which may additionally contain inorganic or organic binders, e.g., film-forming polymers, biocides, protective colloids, or antifoams; considered to read upon the limitations "macromolecular organic or inorganic materials"). This use can be effected in any desired manner, such as by mixing the preparation with water (considered to read upon the "liquid phase" of claim 8), and stirring the resulting slurry treatment materials with the seed (considered to read upon "stirring" in claim 7). See col. 1, lines 28-39 and col. 8, lines 57-63 of Nyssen.

Lastly, while Nyssen discloses that the pigment preparations exhibit a mean weight average particle size of 20 to 2000  $\mu\text{m}$ , the reference is silent with respect to the claimed surface area. It would have been obvious to one of ordinary skill in the art at the time the invention was made to reasonably expect the pigment preparations of Nyssen to exhibit a surface area comparable to that respectively claimed, absent the showing of convincing evidence to the contrary, as this reference teaches pigment preparations (1) containing the same components as recited in Applicants' claims, in comparable percentage ranges, and (2) exhibiting a particle size comparable to that respectively claimed.

It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

### *Response to Amendment*

5. The Declaration under 37 CFR 1.132 filed February 15, 2006, is insufficient to overcome the rejection of claims 1-9 based upon 35 U.S.C. § 103(a) as being unpatentable over Nyssen et al. (U. S. Patent No. 6,646,023), as set forth in the last Office action (and as maintained in this Office Action), because the comparative data therein is

not commensurate in scope with Applicants' claims in their present form. What is recited in the instant claims as component (B) is broader than the specific "block copolymer based on ethylenediamine/propylene oxide/ethylene oxide" disclosed in the Declaration.

### *Response to Arguments*

In response to Applicants' arguments that Nyssen, in the examples, employs "reaction products of hydrogenated castor oil and ethylene oxide", it is the Examiner's position that the disclosed examples are not construed to be the crux of Patentees' invention. As stated in the Office Action, Nyssen discloses that block copolymers obtained by subjecting ethylene oxide and/or propylene oxides onto bifunctional alcohols or amines, which is considered to read upon Applicants' "component (B)". Applicants have not shown that pigment preparations containing the aforementioned block copolymers in Nyssen is significantly inferior to that instantly claimed by Applicants.

For these reasons, Applicants' arguments are not persuasive, and the rejection of record is maintained.

### *Conclusion*

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



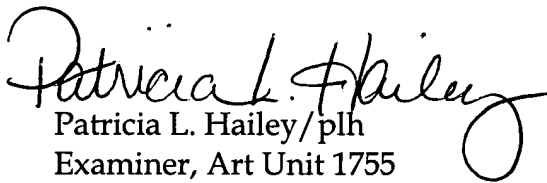
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

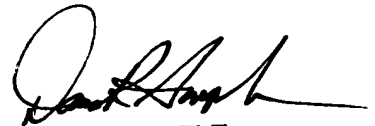
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patricia L. Hailey/plh  
Examiner, Art Unit 1755  
May 15, 2006

  
**DAVID SAMPLE**  
**PRIMARY EXAMINER**